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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,124	11/21/2003	Eric Holze	HOLZ0201	1123

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WESLEY B. AMES  
7031 LOS VIENTOS SERENOS  
ESCONDIDO, CA 92029

EXAMINER
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NEGIN, RUSSELL SCOTT

ART UNIT	PAPER NUMBER
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1631

MAIL DATE	DELIVERY MODE
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08/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/707,124

**Applicant(s)**

HOLZLE, ERIC

**Examiner**

Russell S. Negin

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/27/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Comments***

Applicants' request for reconsideration in the communication filed on 27 May 2007 is acknowledged and the amendments are entered.

Claims 7-13 are pending and examined in the instant Office action.

### ***Drawings***

The replacement drawing filed on 17 August 2006 is objected to. According to 37 CFR 1.84 part (u):

The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

In the instant case, there is a single figure with the application, and so it should follow the above guidelines.

### ***Claim Rejections - 35 USC § 112***

The rejections of claims 1-3 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention are withdrawn in view of amendments made by applicant to the set of claims filed on 27 May 2007.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following rejection is newly applied and necessitated by amendment of applicant on 27 May 2007:

Claims 7-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-13 are dependent from cancelled claim 1. As is stated in section 608.01(n) of the MPEP:

If the base claim has been canceled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete.

Therefore, claims 8-13 are rejected and not examined further on the merits.

Line 3 of claim 7 recites "a plurality of said individuals." It is not clear whether this is the same plurality of said individuals as recited in line 2, or a new plurality of said individuals.

Claim 7 recites "performing a plurality of comparisons between said profiles for a plurality of said individuals, wherein a greater level of heterozygosity between a pair of individuals is indicative of a greater level of compatibility." It is unclear what is meant by "a greater level of heterozygosity between a pair of individuals." It could mean the level of heterozygosity of this pair of individuals for class I or class II is greater than other pairs of individuals for the same genes, or it could mean that the level of heterozygosity of this pair of individuals for class I is greater than that for class II.

***Claim Rejections - 35 USC § 101***

The rejection of claims 1-3 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter is withdrawn in view of amendments made by applicant to the set of claims filed on 27 May 2007.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following rejection is newly applied and necessitated by amendment of applicant on 27 May 2007:

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The following analysis of facts of this particular patent application follows the analysis suggested in the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility". Note that the text of the Guidelines is italicized.

To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways (Guidelines, p. 19):

- The claimed invention "transforms" an article or physical object to a different state or thing.
- The claimed invention otherwise produces a useful, concrete and tangible result.

In the instant case, the claimed invention does not "transform" an article or physical object to a different state or thing because the claimed invention is an

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algorithm for matching individuals based on blood type. This does not preclude the subject matter to be patentable as, for eligibility analysis, as

*physical transformation "is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application." AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If the examiner determines that the claim does not entail the transformation of an article, then the examiner shall review the claim to determine if the claim provides a practical application that produces a useful, tangible and concrete result. In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." The claim must be examined to see if it includes anything more than a § 101 judicial exception. If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101. If the examiner does not find such a practical application, the examiner has determined that the claim is nonstatutory. (Guidelines, p. 20)*

The question is thus whether the final result achieved by the claimed invention satisfies all three criteria of being useful, and concrete, and tangible.

Furthermore, the useful, tangible, and concrete result must be recited in the claim itself, rather than addressed in specification.

(2) **"TANGIBLE RESULT"** The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. The opposite meaning of "tangible" is "abstract."

The instant claims are drawn to means for matching individuals based on MHC profiles. However, as claimed, the method does not produce a tangible result. For example, the method as claimed may take place entirely within the confines of a computer or a human mind without any communication to the outside world and without

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using or making available for use, the results of the computation. Thus, the instant methods of the claims do not produce any tangible result.

Therefore, the final result achieved by the claimed invention does not satisfy all three criteria of being useful, and concrete, and tangible.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Copley [New Scientist, volume 171, no. 2304; August 18, 2001; page 15 (fulltext printout included from DIALOG)].

Claim 7 is drawn to a method for matching partner-seeking individuals in a dating service, comprising determining the MHC class I and Class II genetic profiles of a plurality of said individuals; performing a plurality of comparisons between said profiles for a plurality of said individuals, wherein a greater level of heterozygosity between a pair of individuals is indicative of a greater level of compatibility.

The article of Copley studies how odor influences how rats mate. As stated in lines 9-14 of the text of the fulltext printout:

Rodents sniff their suitors to see whether they have the same major histocompatibility complex genes as their own. MHC genes code for proteins in the immune system, and the more diverse they are, the better your chances of coping with new infections. So rats and mice, at least, follow

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their noses and choose mates with different MHC genes, to endow their offspring with a varied portfolio.

Consequently, Copley studies that rats and mice "mate" (a form of dating) using a plurality of MHC genes. Additionally, Copley shows that rats and mice mate in a way to diversify the portfolio of genes by mating with other rats and mice with different MHC gene profiles (i.e. heterozygosity).

Although Copley does not explicitly disclose MHC Class I and Class II genetic profiles, Copley does disclose a plurality of MHC profiles which are not restricted to a specific class of MHC complex genes.

It would have been obvious at the time of the instant invention for someone of ordinary skill in the art to modify the study of Copley by use of MHC class I and II profiles because the more diverse the genetic profiles in quantity and type, the more likely the rodents will not contract new infections and disease.

### ***Conclusion***

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not



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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the central PTO Fax Center. The faxing of such pages must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Negin, Ph.D., whose telephone number is (571) 272-1083. The examiner can normally be reached on Monday-Friday from 7am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Ram Shukla, Supervisory Patent Examiner, can be reached at (571) 272-0735.

Information regarding the status of the application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information on the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*RSN 7/24/07*

RSN.  
24 July 2007

/Shubo (Joe) Zhou/

SHUBO (JOE) ZHOU, PH.D.  
PRIMARY EXAMINER